



PATENT
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Gary Karlin Michelson, M.D.)
)
Serial No.: 08/354,450)
)
Filed: December 12, 1994)
)
For: DEVICE FOR ARTHROSCOPIC)
MENISCAL REPAIR)

Group Art Unit: 3764

Examiner: D. DeMille

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Box AF
Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

PETITION UNDER 37 C.F.R. § 1.181(a)

In response to the Examiner's Answer dated February 24, 2003 (the "Examiner's Answer"), Appellant petitions the Commissioner to re-open the prosecution of the above-identified application due to improper new grounds of rejection set forth in the Examiner's Answer under 37 C.F.R. § 1.193(a)(2).

I. Background

The above-identified application is on appeal from an Office Action dated March 4, 1996 (the "March 1996 Office Action"). Appellant filed an Appeal Brief and Amendment After Final on July 23, 2002. The Amendment After Final included an amendment to independent claim 19 to incorporate language cited by the Examiner in the March 1996 Office Action as having support in the specification. An Examiner's Answer was mailed February 24, 2003. In the Examiner's Answer, the Examiner indicated that the Amendment After Final had been entered and then raised new

grounds of rejection.

The March 1996 Office Action

In the March 1996 Office Action, a copy of which is attached hereto as Exhibit A, the Examiner rejected former independent claim 19 under 35 U.S.C. § 112, first paragraph, for reasons set forth in the objection to the specification under paragraph 1 of the March 1996 Office Action. Under paragraph 1, the Examiner stated that the specification did not provide support for the height of the projection being greater than the largest dimension of the flexible rear member. Former claim 19 included a recitation that "at least a portion of said flexible projections extending a distance from the central axis of said shaft [is] greater than the width of said flexible member." A copy of claim 19 as it existed from the date of the March 1996 Office Action until the entry of the Amendment After Final is attached hereto as Exhibit B.

The Examiner noted that "the specification does support the limitation that the distance from the top of the projection to the central axis of the shaft is greater than the diameter of the head (said another way, the sum of the radius of the shaft and the height of the projections is greater than the radius of the head)." (March 1996 Office Action, page 2, lines 21-26).

The Examiner suggested that Appellant amend claim 19 to clarify the relationship of the projections and the flexible member. (March 1996 Office Action, page 2, line 26 to page 3, line 3).

The Amendment After Final

In order to reduce the issues on appeal, Appellant amended claim 19 to incorporate the language identified by the Examiner as being supported in the

specification. A copy of the Amendment After Final is attached hereto as Exhibit C.

The Examiner's Answer

In the Examiner's Answer, a copy of which is attached hereto as Exhibit D, the Examiner indicated that the Amendment After Final had been entered. (Examiner's Answer, page 2, paragraph number 4). The Examiner then stated a new ground of rejection of claims 19-24 under 35 U.S.C. § 112, first paragraph, by alleging that the language Appellant inserted into claim 19 was not supported by the specification, contrary to what was indicated in the March 1996 Office Action. (Examiner's Answer, page 4, lines 13-16).

The Examiner also raised lack of support issues with respect to other claims. In particular, while replying to Appellant's arguments to overcome rejections of dependent claims 26 and 27 under 35 U.S.C. § 103(a), the Examiner stated that claim 26 "is not supported by appellant's disclosure" and that "appellant hasn't provided any support of how the specification of the instant invention supports such a limitation [of claim 26]. The same would apply to claim 27...." (Examiner's Answer, page 10, third full paragraph). The March 1996 Office Action did not contain any rejections of claims 26 and 27 under 35 U.S.C. § 112, first paragraph.

In the Appeal Brief, Appellant submitted arguments to overcome the rejection of independent claims 19 and 28 under 35 U.S.C. § 103(a). While replying to Appellant's arguments, the Examiner stated that "Warren discloses the same surgical rivet arrangement as that claimed by appellant. ... It is not clear exactly how the claimed rivet is different from Warren's rivet...." (Examiner's Answer, page 6, lines 3, 10, and 11). The March 1996 Office Action did not contain any rejections of the claims under

35 U.S.C. § 102.

II. Arguments

Appellant submits that the Examiner's Answer raised three impermissible new grounds of rejection: (1) a new rejection of claims 19-24 under 35 U.S.C. § 112, first paragraph; (2) an allegation of a lack of support for claims 26 and 27; and (3) an allegation of anticipation for independent claims 19 and 28. 37 C.F.R. § 1.193(a)(2) states that "[a]n examiner's answer must not include a new ground of rejection...." (37 C.F.R. § 1.193(a)(2)).

A. New rejection of claims 19-24 under 35 U.S.C. § 112, first paragraph

Appellant filed the Amendment After Final concurrently with the Appeal Brief. For an Amendment After Final, 37 C.F.R. § 1.193(a)(2) permits the Examiner to include rejections of claims newly added or amended so long as (1) "appellant was advised (through an advisory action) that the amendment would be entered for purposes of appeal;" and (2) "the advisory action indicates which individual rejection(s) *set forth in the action from which appeal has been taken* would be used to reject the added or amended claims." (MPEP § 1208.01, page 1200-24, paragraph bridging cols. 1 and 2 (August 2001)(emphasis added); 37 C.F.R. § 1.193(a)(2)).

Appellant did not receive an Advisory Action as required by 37 C.F.R. § 1.193(a)(2) and MPEP § 1208.01 once the Amendment After Final had been entered. Further, after Appellant amended claim 19 using language that was indicated in the March 1996 Office Action as being supported by the specification, the Examiner in the Examiner's Answer reversed the earlier position and rejected claim 19, alleging that the language earlier indicated as being supported was now unsupported. (See March 1996

Office Action, page 2, lines 21-26; and Examiner's Answer, page 4, lines 13-16).

MPEP § 1208.01 cites *In re Kronig* for the proposition that "[t]here is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection." (MPEP § 1208.01, page 1200-24, col. 1 (August 2001), citing *In re Kronig*, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976)). Appellant submits that the Examiner's reversal of position concerning the issue of support for claim 19 represents a *prima facie* new ground of rejection in which Appellant was not given "a fair opportunity to react to." (See *In re Kronig* (cited above)).

B. Allegation that claims 26 and 27 lack support in the specification

Appellant submitted arguments in the Appeal Brief to overcome the Examiner's rejections of claims 26 and 27 under 35 U.S.C. § 103(a). However instead of addressing Appellant's arguments on the merits under § 103(a), the Examiner alleged a lack of support for recited elements of each claim. (Examiner's Answer, page 10, third full paragraph). Appellant submits that the Examiner's allegation that claims 26 and 27 are not supported by the specification represent new grounds of rejection for which Appellant has not had a fair opportunity to react to.

C. Allegation of anticipation of independent claims 19 and 28

In the Examiner's Answer, the Examiner made several remarks that are not pertinent to the rejection of independent claims 19 and 28 under 35 U.S.C. § 103(a). (See Examiner's Answer, page 6, lines 3, 10, and 11). From the Examiner's remarks, it is apparent that the Examiner believes that Warren anticipates rather than makes obvious claims 19 and 28. No grounds of rejection alleging anticipation were included

in the March 1996 Office Action. Appellant submits that no fair opportunity has been provided to address the alleged anticipation of claims 19 and 28 by Warren.

III. Conclusion

In view of the above remarks, Applicant respectfully requests the Commissioner to re-open the prosecution of the above-identified application due to the improper new grounds of rejection set forth in the Examiner's Answer under 37 C.F.R. § 1.193(a)(2).

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Petition, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 50-1066.

Respectfully submitted,

MARTIN & FERRARO, LLP

Dated: 4-24-03

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